

REMARKS

Claims 1 and 5-9 are pending in this application. By this Amendment, claim 1 is amended. The amendments introduce no new matter because they are supported by Applicants' disclosure at least at page 20, as originally filed. The Office Action to which this Amendment responds was mailed on January 28, 2008. In reply to the January 28 Office Action, Applicants filed a Request for Reconsideration After Final Rejection on March 17, 2008. In response an Advisory Action was mailed on April 2, 2008 which indicated, in pertinent part, that the Examiner maintained the position that combining the reference is reasonable, that one of ordinary skill in the art would look to the secondary reference for guidance on how to mount the engine of the primary reference. In reply, Applicants filed a Notice of Appeal and Pre-Appeal Brief Request for Review on April 15, 2008 arguing, in a detailed manner, why the conclusions of the Final Rejection, as reiterated in the Advisory Action, were unreasonable. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed on June 19, 2008 indicating that this application remains under appeal. Without conceding the propriety of the arguments set forth in the Final Rejection, as reiterated in the Advisory Action, Applicants amend the pending claims to clarify structural interrelationships between certain of the features recited in, for example, independent claim 1. A Request for Continued Examination is attached. Reconsideration of the application in view of the above amendments and the following Remarks is respectfully requested.

The January 28 Office Action, on page 2, continues to reject claims 1 and 5-9 under 35 U.S.C. §103(a) as being unpatentable over JP-A-57-132051 (hereinafter "JP '051") in view of JP-A-04-015122 (hereinafter "JP '122"). This rejection is respectfully traversed.

The Office Action notes that JP '051 teaches a variable compression ratio engine. The Office Action concedes that JP '051 teaches no manner by which to mount the engine in the vehicle. The Office Action contends that, based on the JP '051 reference being silent as to

any mounting for a variable compression ratio engine in a vehicle, virtually any mounting including alleged mountings described in JP '122 could be used, and reasonably combined with the invention disclosed in JP '051 to render obvious the subject matter of the pending claims.

Applicants have, on four previous occasions, argued that the rejections of at least independent claim 1 are incomplete, and do not meet the applicable standards for showing why one of ordinary skill in the art would have combined the references in the manner suggested with any degree of predictability, or any reasonable expectation of success. In each previous instance, subsequent Office Actions have responded, in the Response to Arguments sections, generally indicating that, because there is no mount shown in JP '051, one of ordinary skill in the art would have been forced to look elsewhere. The Office Actions go on to attempt to rebut Applicants' arguments by asserting that given the disclosure of a support structure for an engine in JP '122, there is nothing in JP '122 that would preclude its use with a variable compression engine even though a fixed compression engine is that which is shown. This is generally the totality of the argument that is set forth to support the conclusion that both references would suggest the asserted combination. This conclusion, now in several Office Actions, is considered to stretch the limits of reasonability regarding the required showing to support an obviousness rejection. "Nothing to preclude" mischaracterizes the disclosure of JP '122 and, moreover, is not the applicable standard.

Applicants reasserted specific arguments regarding the inadequacy of the combination of currently-applied references with respect to the subject matter of the pending claims in the March 17 Request for Reconsideration After Final Rejection.

Without conceding the ongoing propriety of the assertions made in the Office Action, conclusions with which Applicants do not agree, the claims are amended to better distinguish the subject matter recited therein over an even broad construction regarding what this

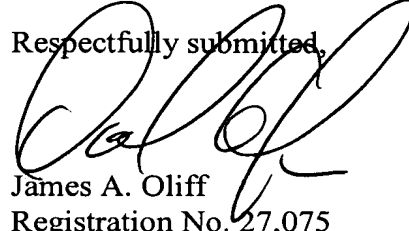
combination of references could reasonably have been considered to have suggested with respect to the subject matter of the pending claims. Specifically, claim 1 is amended to recite wherein a variable wherein a variable compression ratio mechanism comprises: a shaft portion; a cam portion having a circular cam profile fixedly mounted on the shaft portion eccentrically to the center axis of the shaft portion, the cam portion being accommodated in an accommodation bore provided in the cylinder block; and a movable bearing portion having a same outer profile as the cam portion rotatably mounted on the shaft portion in an eccentric way similar to the cam portion, the movable bearing portion being set in an accommodation bore provided in the crankcase, and wherein, by driving the cam portion and the movable bearing portion that are eccentrically provided, the cylinder block is moved along the axial direction of the cylinder relative to the crankcase to vary the compression ratio. No permissible combination of JP '051 with JP '122 can reasonably be considered to have suggested this combination of positively recited features, in addition to the other positively recited features of claim 1.

For at least the foregoing reasons, JP '051 and JP '122 are not combinable in the manner suggested by the Office Action, and any permissible combination of these references would not reasonable have suggested the combination of all of the features positively recited in independent claim 1, and the claims depending therefrom.

Accordingly, reconsideration and withdrawal of the rejection of claims 1 and 5-9 under 35 U.S.C. §103(a) as being unpatentable over the asserted combination of applied references are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1 and 5-9 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,

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JAO:DAT/hms

Attachment:
Request for Continued Examination

Date: July 17, 2008

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